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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,036	09/12/2003	Randall D. Mead	0112300-1409	6686
29159 7590 06/26/2007 BELL, BOYD & LLOYD LLP P.O. Box 1135 CHICAGO, IL 60690			EXAMINER LEUNG, JENNIFER	
			ART UNIT 3714	PAPER NUMBER
			NOTIFICATION DATE 06/26/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

## Office Action Summary

Application No.

10/661,036

Applicant(s)

MEAD ET AL.

Examiner

Jennifer Leung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/2/2004; 9/12/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/23/2004</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Oath/Declaration***

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: page 1 of the declaration incorrectly states that the filing date of the application is 9/2/2003. The correct filing date is 9/12/2003.

### ***Specification***

2. The disclosure is objected to because of the following informalities:

Page 16, line 7: "82" should be -- 62 --.

Page 19, line 29: Delete "not".

Appropriate correction is required.

### ***Claim Objections***

3. Claims 5, 17, 29, 43, and 50 are objected to because of the following informalities:

Claims 5, 17, 29: Delete "of" after "with".

Claim 43: "one pick to use" should be -- one pick to be used --.

Claim 50, line 8: "specification" should be -- specific --.

Appropriate correction is required.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 41, 43, 48-49, and 54-55 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 18, 21, 23-24, and 32-33 of copending Application No. 10/243,047. Although the conflicting claims are not identical, they are not patentably distinct from each other because '047 discloses similar subject matter as application 10/661,036, including picking selections from each selection group until an advance indicator is picked, awarding an award for advancing through each group within a certain number of picks, and use of a data network such as the internet.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
8. Claim 2: recites that a pick by the player does not count. It would be more logical if a pick by the advance (step (b) in claim 1) did not count.
9. Claim 25: the limitation "for each of two picks by the player" render the claim indefinite. Step (a) recites the player picking a selection with an advance. Step (b) recites the advance as picking the second selection. Step (c) does not recite any selection being picked. Therefore, the limitation "for each of two picks by the player" is interpreted to mean two rounds of the game is played by the player before an award is provided to the player.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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**11. Claims 41, 43, 48-49, and 54-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Hughs-Baird (US 6,439,995).**

Re claim 41. Hughs-Baird discloses a method of operating a gaming device including a wagering game, said method comprising: (a) enabling a player to pick from a first selection group until the player picks a first advancement (56, Fig. 8); (b) if the first advancement does not generate a second advancement in a second selection group, enabling the player to pick from the second selection group until the player picks the second advancement in the second selection group (58, Fig. 8); and (c) providing an advance award to the player for advancing through each of the groups if a number of picks used to advance through the groups is less than or equal to a provided number of picks (col. 13, lines 1-43).

Re claim 43. Hughs-Baird discloses requiring at least one pick to use to receive the award (Fig. 8).

Re claim 48. Hughs-Baird discloses providing steps (a) to (c) via a data network or a computer storage device (col. 6, lines 25-30).

Re claim 49. Hughs-Baird discloses wherein the data network includes an internet (col. 6, lines 25-30).

Re claims 54-55. See rejections of claims 48-49 for features of claims 54-55.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**13. Claims 1-40, 44-47, and 50-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughs-Baird (US 6,439,995) in view of Kamille (US 5,855,514).**

Re claim 1. Hughs-Baird discloses a gaming device comprising: a plurality of selection groups (60, 58, 56, Fig. 8); a plurality of selections in each of said selection groups (60, 58, 56, Fig. 8); a plurality of advances adapted to be associated with the selections (66, Fig.8), wherein at least one selection of each of the different selection groups has one of said advances associated with said selection (66, 70, Fig.8); a number of picks from the selection groups adapted to be provided to a player (col. 13, lines 5-10); an advance award adapted to be provided to the player if (col. 7, lines 5-12): (a) the player picks one of the selections with an associated advance (66, Fig.8), and a display device adapted to display the selection groups, advances and advance award (Fig. 8).

However, Hughs-Baird fails to disclose (b) said advance causes the pick of one of the selections associated with a subsequent one of the selection groups, and (c) another one of the advances is associated with said selection caused to be picked by the advance. Kamille discloses such (Fig. 7C; Fig. 6B).

Therefore, in view of Kamille, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the aforementioned limitations in order to save the user time/picks in determining which selection he/she should make in the next group of selections. In addition, it gives players incentive to continue playing knowing that he/she can obtain more awards through advances.

Re claim 2, as understood. Kamille discloses wherein if the player picks one of the selections associated with one of the advances (the Examiner interprets this limitation as the selection that was picked by the advance as in claims 47 and 50), said pick does not count against the number of picks (Fig. 7C: bottom right of the matrix, the player really doesn't pick any selections after the "start" because the advances are in one direction. Thus, it cannot count as a pick).

Re claim 3. Kamille discloses links between selections of two selection groups, wherein each selection associated with a first one of the selection groups is linked to one of the second selections from a second one of the selection groups, and any advance associated with any one of the selections of the first selection group causes the pick of the selection in the second selection group which is linked to said selection in the first selection group (Fig. 6B and 7C).



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Re claim 4. Kamille discloses wherein the display device is adapted to display the selection groups in alignment to show the links between selections of the two selection groups (Fig. 6B and 7C).

Re claim 5. Hughs-Baird discloses wherein a plurality of the advances are adapted to be associated with of a plurality of the selections in at least one of the selection groups (Fig. 7).

Re claim 6. Kamille discloses wherein the selection groups are arranged in an order and a percentage of advances associated with the selections decreases for each subsequent selection group (Fig. 6B).

Re claim 7. Hughs-Baird discloses at least one award associated with one of the selections of one of the groups, wherein said award is adapted to be provided to the player if the player picks said selection or an advance causes the pick of said selection (64, Fig. 8).

Re claim 8. Hughs-Baird, in combination with Kamille, teaches a plurality of awards associated with a plurality of the selections of one of the groups, wherein the player is provided each award associated with the selections picked by the player and the selections caused to be picked by the advance (58, Fig. 8 of Hughs-Baird; Fig. 7C of Kamille).

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Re claim 9. Hughs-Baird, in combination with Kamille, teaches a plurality of awards, one of said awards associated with one of the selections of each of the groups, wherein the player is provided each award associated with the selections picked by the player and the selections caused to be picked by the advance (60, 58, 56, Fig. 8 of Hughs-Baird; Fig. 7C of Kamille).

Re claim 10. Hughs-Baird, in combination with Kamille, teaches a plurality of awards associated with a plurality of the selections of the groups, wherein the player is provided each award associated with the selections picked by the player and the selections caused to be picked by the advance (60, 58, 56, Fig. 8 of Hughs-Baird; Fig. 7C of Kamille).

Re claim 11. Hughs-Baird, in combination with Kamille, teaches a plurality of awards, wherein each selection not having an associated advance has one of said awards associated with said selection, wherein the player is provided each award associated with the selections picked by the player and the selections caused to be picked by the advance (60, 58, 56, Fig. 8 of Hughs-Baird; Fig. 7C of Kamille).

Re claim 12. Hughs-Baird discloses wherein the number of picks is reset upon picking one of the selections having an associated advance (col 13, lines 1-43).

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Re claim 13. In addition to claim 1, Hughs-Baird discloses at least one pick is remaining in step (c) (96, Fig. 7).

Re claims 14-24. See rejections of claims 2-12 for features of claims 14-24.

Re claim 25, as understood. In addition to claim 1, Hughs-Baird discloses for each of two picks by the player (col 13, lines 1-43).

Re claims 26-36. See rejections of claims 2-12 for features of claims 26-36.

Re claim 37. In addition to claim 1, Kamille discloses (c) a second one of the advances is associated with said selection caused to be picked by the advance (Fig. 7C; Fig. 6B); (d) said second advance causes the pick of one of the selections associated with a subsequent one of the selection groups or the advance award (Fig. 7C; Fig. 6B).

Re claim 38. Hughs-Baird discloses a gaming device comprising: a plurality of first selections (56, Fig. 8); a first advance associated with one of the first selections (66, Fig. 8); a plurality of second selections (58, Fig. 8); and a display device operable to display said first selections, first advance, second selections, second advance and advance award (Fig. 8).

However, Hughs-Baird fails to disclose wherein each of the first selections is individually associated with one of the second selections; an advance award adapted to

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be provided to a player if the first selection picked generates the first advance and a second advance is generated by the second selection associated with the picked first selection and provided via the first advance. Kamille discloses such (Fig. 6B and 7C)

Therefore, in view of Kamille, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the aforementioned limitations in order to save the user time/picks in determining which selection he/she should make in the next group of selections. In addition, it gives players incentive to continue playing knowing that he/she can obtain more awards through advances.

Re claim 39. Hughs-Baird discloses at least one award associated with one of the first selections (56, Fig.8).

Re claim 40. Kamille discloses wherein the associations between the first selections and second selections are displayed by the display device as an alignment of the first and second selections (Fig. 6B and 7C).

Re claim 44. Hughs-Bairds discloses the above except for which includes, upon the picking of first advancement, automatically revealing one of the selections in the second group, wherein the automatically revealed selection can yield the second advancement. Kamille discloses such (Fig. 6B).

Therefore, in view of Kamille, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the aforementioned limitations in

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order to save the user time/picks in determining which selection he/she should make in the next group of selections. In addition, it gives players incentive to continue playing knowing that he/she can obtain more awards through advances.

Re claim 45. Kamille discloses wherein the automatically revealed selection in the second group is related to the selection in the first group that yielded the first advancement (Fig. 6B).

Re claim 46. Hughs-Baird, in combination with Kamille teaches, wherein the automatically revealed selection in the second group is randomly chosen upon picking the first advancement (col 17, lines 4-6; col. 17, lines 25-30 of Hughs-Baird; Fig. 6B of Kamille).

Re claim 47. Hughs-Baird discloses the above except for not counting a pick in the second group that yields the second advancement if the pick is a result of a pick of the first advancement in the first group. Kamille discloses such (Fig. 7C and 6B). See rejection of claim 2. If picked by an advancement, the pick is not completed by the player. Thus, it should not count against the player.

Therefore, in view of Kamille, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the aforementioned limitations in order to save the user time/picks in determining which selection he/she should make in

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the next group of selections. In addition, it gives players incentive to continue playing knowing that he/she can obtain more awards through advances.

Re claim 50. In addition to claim 41, Hughs-Baird discloses within a specific number of player picks (col. 13, lines 1-43). However, Hughs-Baird fails to disclose wherein a second advancement is obtained without counting against the number of picks if it is generated directly after the first advancement is generated. Kamille discloses such (Fig. 7C and 6B). See rejection of claim 2. If picked by an advancement, the pick is not completed by the player. Thus, it should not count against the player.

Therefore, in view of Kamille, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the aforementioned limitations in order to save the user time/picks in determining which selection he/she should make in the next group of selections. In addition, it gives players incentive to continue playing knowing that he/she can obtain more awards through advances.

Re claims 51-53. See rejections of claims 44-46 for features of claims 51-53.

**14. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hughs-Baird (US 6,439,995) in view of Jaffe (US 6,443,837).**

Re claim 42. Hughs-Baird discloses the above except for providing a separate number of picks for the first and second selection groups. Jaffe discloses such (col 12, lines 15-20).

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Therefore, in view of Jaffe, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the aforementioned limitations in order to enable the game operator to limit the number of chances a player can increase the bonus award.

### ***Conclusion***


15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kamille discloses a probability game; a method and apparatus for redeeming a game piece. Barrie discloses a gaming apparatus and method having an integrated first and second game. Gilmore discloses a gaming machine with concealed image bonus feature. Glavich discloses a gaming device having a bonus scheme including a plurality of selection groups with win-group outcomes; a gaming device having a random directional bonus scheme. Kaminkow discloses a gaming device having a multiple selection group bonus round. Eklund discloses a device for manufacturing playing counters and drawing sequences in a lottery. Walker discloses a lottery game card and method for conducting a lottery game. Gauselmann discloses a bonus game displaying and awarding selected values.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Leung whose telephone number is 571-270-1342. The examiner can normally be reached on Mon -Thur, every other Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Jennifer Leung  
June 20, 2007

  
Robert E. Pezzuto  
Supervisory Patent Examiner  
Art Unit 3714